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EXAMINER	
SALTARELLI, DOMINIC D	
ART UNIT	**PAPER NUMBER**
2421	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/631,583	LIWERANT ET AL.	
	Examiner	Art Unit	
	DOMINIC D. SALTARELLI	2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 January 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12 and 36-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12 and 36-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 15, 2009 have been fully considered but they are not persuasive.

First, applicant argues that claim limitations directed to "assuring" or "confirming" that a video is in a streaming format inherently involves a positive action in the form of a determination made by analyzing a file to determine if it is already in a streaming video format (applicant's remarks, page 6).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., analyzing a file to determine if it is already in a streaming video format) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the prior art teaches that the video being shared from the server is guaranteed to be in a streaming format upon sending the video ("Streaming Email, page 311). This is sufficient to both assure and confirm that the video is in a streaming format.

Second, applicant argues that the prior art teaches away from the claimed invention, in that the claimed invention does not require a specialized player to viewing video files (applicant's remarks, pages 6-7).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., there is no need for a specialized player) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, applicant argues "…having an attached application be transmitted to a recipient of the email would go against the objective of minimizing the size of a file to be transmitted via email, which is one of the reasons why the video of the present invention is presented in a streaming video format" (applicant's remarks, page 7).

In response, the "Streaming Email" document states on page 312:

"To send messages faster, don't send the Video Express Email player or the actual downloadable multimedia file. These seriously slow down your transmission, especially with large files. Only send downloadable files if your recipient absolutely needs a copy for offline viewing."

Third, applicant's argue that there is no motivation to combine the teachings of the Sezan patent, stating that the purpose of Sezan's thumbnails is to assist a user in selecting from among a plurality of displayed choices (applicant's remarks, page 7).

In response, this particular application for thumbnails (selecting from a group of displayed choices) does not detract from the stated reason for incorporating thumbnails as proposed by the examiner. The purpose of thumbnails being taught and exploited by Sezan is that they give a user an indication of what the content of a particular video, represented by the thumbnail, consists of. Sezan takes this a step further and uses this cited benefit for user selection in an environment of multiple possible choices to pick from. This however, is not a mandatory feature of thumbnails, and thus is not necessary to incorporate when considering Sezan as a whole.

Lastly, applicant's argue that Ellis does not constitute prior art, claiming an effective filing date of August, 3, 1999 (applicant's remarks, page 8).

However, as disclosed in the office action mailed on March 7, 2007, the effective filing date of applicant's invention is not the provisional filed on August 3, 1999, since each of the independent claims include limitations not disclosed by the provisional. Specifically regarding claim 7, steps (i)-(iv) performed by a video server are not found in the provisional application, thus the invention described by the claim is not granted the effective filing date of the provisional.

2. Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-6, and 36-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild (US 2001/0047294 A1, of record) in view of "Streaming Email" (XP-002150023, supplied by applicant) and Sezan et al. (6,236,395, of record) [Sezan].

Regarding claim 1, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment from a sender at a computer system (the video portion of a video message which is the personal communication, paragraph 48);

(b) acquiring advertisements from advertisers at the computer system (third party, advertiser provided advertisements, paragraph 49);

(c) offering to the sender an opportunity to indicate a selection of an advertisement of the advertisements to be associated with the video segment (pull down menu 404, paragraph 51);

(d) accepting from the sender the indication of a selection of the advertisement to be associated with the video segment (the send message button which indicates the sender has selected the desired advertisement and is ready to send the message, paragraph 53).

Rothschild fails to disclose acquiring a still image in the form of a thumbnail and directly in response to the indication accepted in step (d), automatically at the computer system:

(i) assuring that the video segment is in a streaming format;

(ii) creating an identifier for the video segment, wherein the identifier includes the still image and a link to the video;

(iii) associating the video segment and the advertisement; and

(iv) sending the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Regarding claim 2, Rothschild, "Streaming Email", and Sezan disclose the method of claim 1, wherein the step of offering to a sender an opportunity to indicate a selection of an advertisement of the advertisements includes a criterion selectable by the sender (via pull down menu 404, Rothschild, paragraph 51).

Regarding claim 3, Rothschild, "Streaming Email", and Sezan disclose the method of claim 2, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 4-6, Rothschild, "Streaming Email", and Sezan disclose the method of claims 1 and 2, and further disclose the step of offering to a sender an opportunity to indicate a selection of an advertisement includes a randomized default selection if the sender fails to indicate a selection (Rothschild, paragraph 52, where if the sender fails to select a particular advertisement, they may select that a randomly selected advertisement be shown).

Regarding claim 36, Rothschild teaches a method for operating a video-sharing server on a network comprising:

storing a plurality of advertisements from advertisers (paragraph 64); and

receiving from a client a video, an electronic email address, and a selection of one of the plurality of advertisements (paragraph 57, wherein the email is a video message, paragraph 48).

Rothschild fails to disclose receiving a still image in the form of a thumbnail confirming that the video is in streaming format, storing the video at a network-accessible location, generating an identification tag including a link and the still image to the network accessible location, generating an electronic communication containing the identification tag and addressed to the electronic email address, and transmitting the electronic communication.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible

location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format, as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Regarding claim 37, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, wherein receiving the video includes receiving an HTTP post (Rothschild teaches the email is assembled and transmitted via interactions with web site 110, paragraph 48).

Regarding claim 38, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, but fail to disclose publishing the link to a Web page.

Publishing links to videos in web pages is notoriously well known in the art.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method of Rothschild, "Streaming Email", and Sezan to include publishing the link to a Web page.

Regarding claim 39, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, further comprising receiving a mailing list including a plurality of email addresses and transmitting the electronic message to the plurality of email messages (Rothschild teaches sending a single message to multiple recipients at once, paragraph 53).

Regarding claim 40, Rothschild, "Streaming Email", and Sezan disclose the method of claim 36, wherein the link includes a path ("Streaming Email"

teachings sending a pointer file which designates the location of the file for streaming, page 308).

5. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild in view of "Streaming Email", Ellis et al. (6,774,926, of record), and Sezan.

Regarding claim 7, Rothschild discloses a method of sending a video segment and an associated advertisement over a computer network (paragraph 48), comprising:

(a) acquiring a video segment at a computer system (the video portion of a video message, paragraph 48);

(b) selecting, by the sender, an advertisement stored at the server computer system by an advertiser (paragraphs 51-52); and

(c) transmitting from the sender computer to the server computer system an indication of the selected advertisement (paragraph 53).

Rothschild fails to disclose fails to disclose uploading a video segment and a still image in the form of a thumbnail from a sender computer system to the server computer system, and in response to receiving said indication the server computer system automatically:

(i) assures that the video segment is in a streaming format;

(ii) creates an identifier for the video segment, wherein the identifier includes the still image and a link to the video segment;

(iii) associates the video segment and the advertisement; and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, Ellis teaches uploading a video segment from a sender computer system to a server computer system (col. 3 line 55 – col. 4 line 4 and col. 7, lines 38-48), allowing smaller entities, such as home users, to create and provide video content (col. 3, lines 19-29).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include uploading a video segment from a sender computer system to the server computer system, as taught by Ellis, for the benefit of allowing smaller entities, such as home users, to create and controllably provide video content, such as personalized, or special interest, content.

Rothschild and Ellis fail to disclose uploading a still image in the form of a thumbnail in response to receiving said indication the server computer system automatically:

(i) assures that the video segment is in a streaming format;

(ii) creates an identifier for the video segment, wherein the identifier includes the still image and a link to the video segment;

(iii) associates the video segment and the advertisement; and

(iv) sends the video segment, the identifier, and the associated advertisement over the computer network to a receiving computer system.

In an analogous art, "Streaming Email" teaches sending video email messages in streaming format by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (pgs. 308-313, "Video Express Email"), providing the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild to include sending video email messages in streaming format (i) by creating a pointer included in a text email message sent to a designated recipient which points to the network accessible location where the video has been stored in said streaming format (ii-iv), as taught by "Streaming Email" for the benefit of sharing video messages with others that does not require transmission of the full video along with the email.

Rothschild, Ellis, and "Streaming Email" fail to disclose acquiring a still image in the form of a thumbnail and the identifier created includes the still image.

In an analogous art, Sezan teaches generating and associating thumbnail images with a video file in order to assist users in selecting video content for viewing (col. 4 line 40 - col. 5 line 2).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, and "Streaming Email" to include associating a thumbnail image with the video file, as taught by Sezan, for

the benefit of assisting users in selecting video content for viewing, as a thumbnail image provides a user with a brief hint or indicator as to the content of the video, and assists a viewer in deciding whether to view the entire file.

Regarding claim 8, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 7, wherein selecting an advertisement comprises using a criterion chosen by an operator of the sender computer system (Rothschild, paragraph 52).

Regarding claim 9, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 8, wherein said criterion is a remuneration paid for selected said advertisement (Rothschild, paragraph 49).

Regarding claims 10 and 11, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 8, wherein said criterion includes leaving said selection to the determination of said server computer system which selects the advertisement in a substantially randomized manner (Rothschild, paragraph 52).

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothschild, Ellis, "Streaming Email", and Sezan as applied to claim 10 above, and further in view of Eldering et al. (6,820,277, of record) [Eldering].

Regarding claim 12, Rothschild, Ellis, "Streaming Email", and Sezan disclose the method of claim 10, but fail to disclose said selection is based on a price paid by the advertiser.

In an analogous art, Eldering discloses providing advertisers the opportunity to bid upon advertisement opportunities, awarding the advertisement time slot to the highest bidder (col. 8 line 63 – col. 9 line 12).

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rothschild, Ellis, "Streaming Email", and Sezan to select an advertisement based on a price paid by the advertiser, as taught by Eldering, for the benefit of allowing advertisers to bid upon advertisement opportunities, maximizing the advertising revenues generated by the server computer system.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOMINIC D. SALTARELLI whose telephone number is (571)272-7302. The examiner can normally be reached on Monday - Friday 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Dominic D Saltarelli/
Primary Examiner, Art Unit 2421